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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,943	06/08/2001	Ken Alan Berkun	PU010083	9074
25096	7590	03/31/2009	EXAMINER	
PERKINS COIE LLP			BENGZON, GREG C	
PATENT-SEA			ART UNIT	PAPER NUMBER
P.O. BOX 1247			2444	
SEATTLE, WA 98111-1247			MAIL DATE	
			03/31/2009	
			DELIVERY MODE	
			PAPER	

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KEN ALAN BERKUN, AUSTIN DAVID DAHL,  
JENNIFER LYNN KOLAR, SCOTT CHAO-CHUEH LEE,  
SANNON E. MCRAE, BRAD STEVEN MILLER, JOHN PRINCE,  
ERIC CARL REHM, SRINIVASAN SUDANAGUNTA,  
and JONATHAN ROBERT NOWITZ

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Appeal 2008-3005  
Application 09/876,943  
Technology Center 2400

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Decided:<sup>1</sup> March 31, 2009

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Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and  
THU A. DANG, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

### STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-17, which are all the claims pending. We have jurisdiction under 35 U.S.C. § 6(b). Oral argument by Appellants' representative was heard on March 18, 2009.

#### *Invention*

Appellants claim a method and system for enhancing metadata associated with media (e.g., multimedia and streaming media). (Abstract.) "Metadata" is data about data. (Spec. ¶ [0025]). The metadata is modified if a comparison with a valid metadata database indicates that the acquired metadata does not match the corresponding valid metadata. (Abstract.)

#### *Representative Claims*

1. A method for enhancing metadata associated with media on a communications network, said method comprising the steps of:
  1. parsing said metadata associated with said media into a least one field of metadata;
  2. comparing contents of each of said at least one field of metadata with contents of at least one field of metadata from an authoritative source, each field of metadata compared with each field of authoritative metadata being a compared filed; and
  3. modifying said metadata if said compared field contents do not match the contents of at least one field of authoritative metadata.

9. a computer system for enhancing metadata associated with media on a computer network, said computer system comprising at least one computer, all computers in said system being communicatively coupled to each other, wherein each of said at least one computer includes at least one program stored therein for allowing communication between each and every of said at least one computer, each of said at least one program operating in conjunction with one another to cause said at least one computer to perform the steps of:

    parsing said metadata associated with said media into at least one field of metadata;

    comparing contents of each of said at least one field of metadata with contents of at least one field of metadata from an authoritative source, each field of metadata compared with each field of authoritative metadata being a compared field; and

    modifying said metadata if said compared field contents do not match contents of at least one field [sic] authoritative metadata.

*Prior Art*

The Examiner relies on the following references as evidence of unpatentability.

Chu	US 6,493,720 B1	Dec. 10, 2002
Srivastava	US 6,549,922 B1	Apr. 15, 2003
		(filed Oct. 1, 1999)

*Examiner's Rejections*

Claims 1-17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-3, 5-11, and 13-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Srivastava.<sup>2</sup>

Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Srivastava and Chu.

#### *Decision Summary*

We reverse the Examiner's rejection of claims 1-17 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner's rejection of claims 9 and 10 under 35 U.S.C. § 102(e) as being anticipated by Srivastava.

We do not reach the prior art rejections applied against claims 1-8 and 11-17, as the claims are not directed to patent eligible subject matter.

We enter new grounds against claims 1-8 and 11-17, *infra*, in accordance with 37 C.F.R. § 41.50(b).

#### PRINCIPLES OF LAW -- INDEFINITENESS

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 1577 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a

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<sup>2</sup> The Answer indicates that Srivastava is a reference under 35 U.S.C. § 102(b). However, the Srivastava patent issued (15 Apr. 2003) after the filing date of the instant application (08 Jun. 2001).

particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235. The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

#### ANALYSIS -- INDEFINITENESS

The Examiner's rejection of the claims under 35 U.S.C. § 112, second paragraph, is based on the allegation that Appellant has not provided "sufficient guidance" such that one may ascertain the meaning of "authoritative metadata" and "authoritative source" as used in the claims. (Ans. 4-5.)

In our view, the rejection does not set forth a sufficient basis to explain why the terms should be considered to render the claims indefinite. The Specification, particularly at paragraphs [0042] through [0046], indicates that "authoritative" or "valid" metadata refers to reference metadata to which other metadata, considered to be less likely reliable, is compared. We do not read the "authoritative metadata" and the "authoritative source" in the claims as requiring any particular type of metadata from any particular source, or that the "authoritative" metadata is required to be, in actuality, more likely correct. The "authoritative metadata" is simply reference metadata that may be deemed to be more reliable than the metadata which is compared to the "authoritative" metadata.

Thus, although the terms are certainly broad, the terms that provide the basis for the rejection do not render the claims indefinite, in our estimation. We thus do not sustain the rejection of claims 1-17 under 35 U.S.C. § 112, second paragraph.

## FINDINGS OF FACT

### *Srivastava*

Srivastava describes a system for automatic extraction and transformation of metadata into logical annotations. Srivastava Abstract. The reference uses the terms “metadata” and “annotations” interchangeably. *Id.*, col. 2, ll. 32-39.

As shown in Figure 1, a metadata extractor 111 parses the file of media data 113 to extract metadata embedded within the file. A sample extractor 115 generates additional information from the file. Srivastava col. 2, ll. 40-50; col. 4, 1. 31 - col. 5, 1. 11.

Auxiliary metadata processing 117 (Fig. 1) provides information that is not obtainable from the media file itself. Predetermined, standardized metadata content can be gathered from look-up services available on the Internet or from the user’s input. Srivastava col. 5, ll. 12-22.

Transformer 116 (Fig. 1) combines the media information to construct logical annotations which contain attribute value pairs. Srivastava col. 5, 1. 23 - col. 6, 1. 7.

A GUI (graphical user interface) window (Fig. 2) is available on the client computer 130 (Fig. 1). The pane selected by clicking on the Attributes tab at 242 shows the attributes of the annotation. The user can change the attribute values. Srivastava col. 4, ll. 14-19.

In particular, the user can edit a value by selecting an attribute and entering the desired value in the right-hand table cell (Fig. 2). Srivastava col. 7, ll. 26-46.

#### PRINCIPLES OF LAW -- ANTICIPATION

With respect to anticipation, “the first inquiry must be into exactly what the claims define.” *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970). The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d at 322.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

However, the law of anticipation does not require that a reference “teach” what an applicant’s disclosure teaches. Assuming that a reference is properly “prior art,” it is only necessary that the claims “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or “fully met” by it. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

#### ANALYSIS -- ANTICIPATION

Based on Appellants’ arguments in the Appeal Brief, we will decide the appeal with respect to the claims not subject to new grounds of rejection (claims 9, 10) on the basis of claim 9 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Srivastava describes parsing metadata associated with media into at least one field of metadata, such as the field from which the value “Quicktime file” is displayed in Figure 2. As we have indicated in the Findings of Fact section, Srivastava discloses that the user can edit a value (e.g., “Quicktime file” in Figure 2). The client computer compares the contents of the present field of metadata with contents of a field provided by an authoritative source -- i.e., the user -- by means of the GUI. The client computer modifies the metadata (e.g., “Quicktime file” value) if the present (compared) field contents do not match the field contents entered by the user.

Srivastava thus describes all that claim 9 requires.<sup>3</sup> We have considered all of Appellants' arguments in the Appeal Brief but are not persuaded that the broad terms of claim 9 are not anticipated by Srivastava. The arguments seem not to appreciate that the submitted claim does not distinguish over human help, or human entry of data, in the "comparing" step as described by Srivastava.

We therefore sustain the rejection of claims 9 and 10 under 35 U.S.C. § 102(e) as being anticipated by Srivastava.

#### NEW GROUNDS OF REJECTION -- 37 C.F.R. § 41.50(b)

##### *I.*

We reject claims 1-8 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C. § 101. "[N]o patent is available for a discovery, however useful, novel, and nonobvious, unless it falls within one of the express categories of patentable subject matter of 35 U.S.C. § 101."

*Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 483 (1974).

If base claim 1 is directed to statutory subject matter, the claim falls within the statutory class of "process." "A process is . . . an act, or a series of acts, performed upon the subject matter to be transformed and reduced to

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<sup>3</sup> Although the preamble represents an intended use recitation that is not entitled to weight in the patentability analysis, even if it were so entitled, the preamble specifies that the "computer system" comprises "at least one" computer. The system, by its terms, can consist of exactly one computer.

a different state or thing.” *Cochrane v. Deener*, 94 U.S. 780, 788 (1877). “Transformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.” *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)).

Our reviewing court recently held that the “useful, concrete and tangible result” inquiry, first set forth in *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) (en banc), is inadequate to determine whether a claim is patent-eligible under 35 U.S.C. § 101. *See In re Bilski*, 545 F.3d 943, 959-60 (Fed. Cir. 2008) (en banc). The Supreme Court’s “machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *Id.* at 956. “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954.

Claim 1 fails the first branch of the “machine-or-transformation” test. The claim does not recite a particular machine or apparatus, nor, for that matter, *any* machine or apparatus. Although the claim might be broad enough to read on statutory embodiments, the claim is not so limited. “The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007), *cert. denied*, \_\_\_ U.S. \_\_\_, 129 S. Ct. 70 (2008).

Claim 1 also fails the second branch of the “machine-or-transformation” test. The claim does not contain or require an *article* that is transformed and reduced “to a different state or thing.” *See Diamond v. Diehr*, 450 U.S. at 184.

In *Bilski*, our reviewing court identified a circumstance in which *electronic transformation of data into a particular visual depiction of a physical object on a display* may be considered a transformation sufficient to render a claimed process patent-eligible. *See Bilski*, 545 F.3d at 962-63 (discussing *In re Abele*, 684 F.2d 902, 908-09 (CCPA 1982)).

Even if we were to assume that Appellants’ claimed metadata is limited to data in a machine -- it is not -- the transformation (i.e., “parsing” and “modifying” metadata) does not appear to be a type of “transformation” that is recognized by our reviewing court, or by the U.S. Supreme Court, sufficient to render a claimed method patent-eligible.

The dependent claims (2-8) do not add anything of substance to base claim 1. Claim 4 recites “providing” media files to a “format specific metadata extractor.” If we assume that the “extractor” requires some kind of machine implementation -- even though the claim does not require any sort of extraction or output from the “extractor” -- the recitation does not impose meaningful limits on the claim’s scope to impart patent-eligibility. *See Bilski* at 962 (“[T]he involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.”).

## II.

We reject claims 11-17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Each of claims 11-17, as recited in base claim 11, is directed to a “computer data signal embodied in a carrier wave.” A carrier wave or signal does not fall within any of the four categories of statutory subject matter, and is thus not statutory subject matter. *See In re Nuijten* at 1357.

## DECISION

The Examiner’s rejection of claims 1-17 under 35 U.S.C. § 112, second paragraph is reversed.

The Examiner’s rejection of claims 9 and 10 under 35 U.S.C. § 102(e) as being anticipated by Srivastava is affirmed.

We do not reach the prior art rejections applied against claims 1-8 and 11-17, as the claims are not directed to patent eligible subject matter. The appeal with respect to the rejection of claims 1-8 and 11-17 over the prior art (35 U.S.C. § 102 or 103) stands *dismissed*.

In new grounds of rejection, we have rejected claims 1-8 and 11-17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART -- 37 C.F.R. § 41.50(b)

APJ Initials:

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PERKINS COIE LLP  
PATENT-SEA  
P.O. BOX 1247  
SEATTLE WA 98111-1247